



Patent  
231/039 (prev. 6646-101NH)

*K. Ward*  
*5/8/00*  
*#61*  
*Amold*  
*int*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

**Ronald A. KATZ**

**Serial No.:** 09/006,274

**Filed:** January 13, 1998

**For:** TELEPHONIC-INTERFACE  
STATISTICAL ANALYSIS SYSTEM

**Group Art Unit:** 2748

**Examiner:** F. Tsang

Office Action mailed:

October 25, 1999

**RECEIVED**

**MAY - 5 2000**

**Group 2700**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**AMENDMENT AND RESPONSE TO OFFICE ACTION**

Dear Sir:

In response to the Office Action dated October 25, 1999, please amend the above-identified patent application as follows:

**IN THE SPECIFICATION:**

On page 3, line 12, delete the comma after "When."

On page 3, line 29, delete "&" and insert --a--.

On page 4, line 28, delete "and" at the end of the sentence.

On page 4, line 30, delete the period at the end of the sentence and insert --; and--.

On page 4, line 31, insert --FIGURE 9 is a block diagram of the connections between the

CPU and remote stations.--

On page 6, line 3, delete the comma after "data."

**CERTIFICATE OF MAILING UNDER 37 CFR 1.8**

I hereby certify that this document (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C., 20231.

April 25, 2000

Date

*Reena Kuyper*  
Reena Kuyper, Registration No. 33,830

LA-139225.1

*53*

On page 7, line 20, change "11211" to --"2"--.  
On page 7, line 22, change "110-911" to --"0-9"--.  
On page 7, line 26, insert --"\*"-- after "symbols."  
On page 7, line 26, change "11#11" to --"#"--.  
On page 7, line 27, change "O" to --0--.  
On page 8, line 5, delete the comma after "of."  
On page 8, line 7, change "PI" to --P1--.  
On page 8, line 13, change "AC1ACn" to --AC1-ACn--.  
On page 10, line 9, delete the comma after "alternatives" and insert a period.  
On page 10, line 11, delete "callers" and insert --callers'--.  
On page 10, line 22, change "f or" to --for--.  
On page 13, line 3, change "6272222" to --627-2222--.  
On page 13, line 30, change "11(213)" to --"(213)--.  
On page 13, line 31, delete the period after "interface."  
On page 14, line 6, delete the comma after "number."  
On page 15, line 5, change "11(213)" to --"(213)--.  
On page 15, line 13, delete the comma after "is."  
On page 15, line 15, change "onetime" to --one-time--.  
On page 16, line 2, change "115311" to --"53"--.  
On page 17, line 11, change "11495168411" to --"4951684"--.  
On page 18, line 4, change "6173.11" to --6173.--.  
On page 18, line 15, change "transaction-is" to --transaction is--.  
On page 18, line 20, change "88 ." to --88.--.  
On page 22, line 21-22, delete "(by voice cue) to provide" and insert --by the voice

generator to provide (by voice)--

On page 26, line 1, delete the comma after "collected."  
On page 27, line 9, after "currently" insert --a--.  
On page 27, line 11, after "calculator" insert --100--.  
On page 29, line 6, change "for" to --for--.  
On page 32, line 25, change "PR1PRn" to --PR1-PRn--.  
On page 33, line 9, change "sizable-number" to --sizable number--.

On page 35, line 15, delete the comma after "qualified."

On page 37, line 23, change "11277-777711" to --"277-7777"--.

On page 43, line 26, change "installed-for" to --installed for--.

On page 43, line 27, change "of" to --Of--.

On page 47, line 11, change "such data.," to --such data,--.

### REMARKS

This Amendment is responsive to the office action dated October 25, 1999.

In paragraph 1 of the office action, the Examiner requested that Applicant either state the class/subclass section for every reference cited in the Information Disclosure Statement or cross the class/subclass section with a straight line in order to alleviate the Examiner from having to do so. The undersigned apologizes for burdening the Examiner with that task. In the event the Examiner has not yet undertaken that task, the undersigned is enclosing a copy of the forms PTO-1449 submitted before with lines to cross the class/subclass sections for every reference. The undersigned notes that the Examiner has only returned page 1 of the forms PTO-1449 submitted, bearing his signature to formally indicate that he has considered the references cited by Applicant. The undersigned respectfully requests the Examiner to execute the enclosed forms and return a copy to the Applicant for his files.

Applicant also notes that the official filing receipt sent the U.S. Patent and Trademark Office does not accurately indicate the chain of applications from which the present application claims priority. A copy of official filing receipt with an indication of the missing applications is attached with this response. Applicant respectfully requests that the record in the file be updated to reflect the accurate chain of priority.

In addition, Applicant is requesting the above amendments to the original specification to correct inadvertent and obvious errors.

In paragraphs 3, 4, and 5, the Examiner rejects the present claims under 35 U.S.C. Section 103(a) as unpatentable over Szlam in view of Moosemiller or Kraus and further in view of Crane. Applicant submits that to combine the references there must be a suggestion in the references indicating the desirability to combining them as suggested by the Examiner. To that end, Applicant requests the Examiner to consider the following case law. It is immaterial to the issue of obviousness that all of the elements were old in the art. Gillette Co. v. S.C. Johnson &

Son, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). Virtually all inventions are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983). Moreover, the new combination need not provide unexpected results or synergism. American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1360-61, 220 USPQ 763, 771 (Fed. Cir. 1984). The question is not whether each element in a claimed invention is old and unpatentable, but whether "there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1575, 1 USPQ2d 1593, 1602-03 (Fed. Cir. 1987). The claimed invention must be considered as a whole. Gillette Co. v. S.C. Johnson & Son, Inc., 919 F.2d at 724, 16 USPQ2d at 1927.

Applicant respectfully submits that the Office Action engages in impermissible hindsight reconstruction of the claimed invention, using Applicant's claims as a template and selecting elements from references to fill the gaps. E.g., In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

In paragraphs 6, 7, and 8, the Examiner rejected the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of Applicant's earlier issued patent no. 5,815,551. The Examiner acknowledges that the present claims are not identical to those in the parent and indicates that they are broader in scope. Although the claims are different, to expedite allowance of this application, Applicant is submitting a terminal disclaimer to obviate the double patenting rejection.

Favorable consideration and allowance of the claims here is respectfully requested.

Respectfully submitted,

LYON & LYON, LLP

By: 

Reena Kuyper

Registration No. 33,830

Dated: April 25, 2000

633 W. Fifth Street, Suite 4700  
Los Angeles, CA 90071-2066  
(213) 489-1600

FILING RECEIPT

RECEIVED APR 21 1998



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
09/006,274	01/13/98	2743	\$790.00	228039 231/039	6	13	2

RECEIVED

NILSSON ROBBINS DALGARN  
BERLINER CARSON & WURST  
201 NORTH FIGUEROA STREET  
FIFTH FLOOR  
LOS ANGELES CA 90012

MAY - 5 2000

Group 2700

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Application Processing Division's Customer Correction Branch within 10 days of receipt. Please provide a copy of the Filing Receipt with the changes noted thereon.

Applicant(s)

RONALD A. KATZ, LOS ANGELES, CA.

CONTINUING DATA AS CLAIMED BY APPLICANT-

THIS APPLN IS A CON OF 08/473,320 06/07/95 PAT 5,815,551

FOREIGN FILING LICENSE GRANTED 04/09/98

TITLE

TELEPHONIC-INTERFACE STATISTICAL  
ANALYSIS SYSTEM

PRELIMINARY CLASS: 379

DOCKETED FOR

Nov. 13, 1999  
Jan. 13, 1999

BAR

WHICH IS A CON OF 07/335,923 04/10/89 PAT 6,016,344  
WHICH IS A CON OF 07/194,258 05/16/88 PAT 4,845,739  
WHICH IS A CIP OF 07/018,244 02/24/87 PAT 4,792,968  
WHICH IS A CIP OF 06/753,299 07/10/85 ABN.

RECEIVED  
MAY 07 1998  
U.S. PROSECUTION